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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/759,425	01/20/2004	Kang Soo Seo	1740-000066/US	7761
30593	7590	02/20/2009	EXAMINER	
HARNESS, DICKEY & PIERCE, P.L.C. P.O. BOX 8910 RESTON, VA 20195			NGUYEN, HUY THANH	
			ART UNIT	PAPER NUMBER
			2621	
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			02/20/2009	PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary	Application No. 10/759,425	Applicant(s) SEO ET AL.	
	Examiner HUY T. NGUYEN	Art Unit 2621	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 12 November 2008.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 15-18,20,21,23-25,27,28,30-32,34,35,37-39,41,42 and 44-46 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 15-18,20-25,27,28,30-32,34,35,37-39,41,42 and 44-46 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)
Paper No(s)/Mail Date <u>12/31/08,11/12/08</u> . | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

1. A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on 11/12/2008 has been entered.

Allowable Subject Matter

2. The indicated allowability of claims is withdrawn in view of the newly discovered reference(s) to 6574419 and US 20050019007. Rejections based on the newly cited reference(s) follow.

Double Patenting

3. The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. A nonstatutory obviousness-type double patenting rejection is appropriate where the conflicting claims are not identical, but at least one examined application claim is not patentably distinct from the reference claim(s) because the examined application claim is either anticipated by, or would have been obvious over, the reference claim(s). See, e.g., *In re Berg*, 140 F.3d 1428, 46 USPQ2d 1226 (Fed. Cir. 1998); *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) or 1.321(d) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent either is shown to be commonly owned with this application, or claims an invention made as a result of activities undertaken within the scope of a joint research agreement.

Art Unit: 2621

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

4. Claims 15-18,20-21,23-25,27-28,30-32,34-35,37-39,41-42 and 44-46 are provisionally rejected on the ground of nonstatutory obviousness-type double patenting as being unpatentable over claims 1-2,4,6-11,15,33-38,40-42,46-47,49-52,54 of copending Application No. 10/766,193. Although the conflicting claims are not identical, they are not patentably distinct from each other because the difference between claims 15-18,20-21,23-25,27-28,30-32,34-35,37-39,41-42 and 44-46 of the present application and claims 1-2,4,6-11,15,33-38,40-42,46-47,49-52,54 of copending Application No. 10/766,193 is that claims 1-2,4,6-11,15,33-38,40-42,46-47,49-52,54 of copending Application No. 10/766,193 further recite an entry point map for specifying in points and outpoint s of the fist stream that is not found in claims 15-18,20-21,23-25,27-28,30-32,34-35,37-39,41-42 and 44-46 of the present application . Since claim 1-2,4,6-11,15,33-38,40-42,46-47,49-52,54 of copending Application No. 10/766,193 encompass the claims 15-18,20-21,23-25,27-28,30-32,34-35,37-39,41-42 and 44-46 of the present application , it would have been obvious to one of ordinary skill in the art to modify claims 1-2,4,6-11,15,33-38,40-42,46-47,49-52,54 of copending Application No. 10/766,193 to produce claims 15-18,20-21,23-25,27-28,30-32,34-35,37-39,41-42 and 44-46 of the present application.

This is a provisional obviousness-type double patenting rejection because the conflicting claims have not in fact been patented.

Art Unit: 2621

5. Claims 15-18,20-21,23-25,27-28,30-32,34-35,37-39,41-42 and 44-46 are provisionally rejected on the ground of nonstatutory obviousness-type double patenting as being unpatentable over claims 1-6,8-16,18-45 of copending Application No. 10/766,239. Although the conflicting claims are not identical, they are not patentably distinct from each other because the difference between claims 15-18,20-21,23-25,27-28,30-32,34-35,37-39,41-42 and 44-46 of the present application and claims 1-6,8-16,18-45 of copending Application No. 10/766,239 is that claims 1-6,8-16,18-45 of copending Application No. 10/766,239 further recite an entry point map for specifying in points and outpoint s of the first stream that is not found in claims 15-18,20-21,23-25,27-28,30-32,34-35,37-39,41-42 and 44-46 of the present application . Since claims 1-6,8-16,18-45 of copending Application No. 10/766,239 encompass the claims 15-18,20-21,23-25,27-28,30-32,34-35,37-39,41-42 and 44-46 of the present application , it would have been obvious to one of ordinary skill in the art to modify claims 1-6,8-16,18-45 of copending Application No. 10/766,239 to produce claims 15-18,20-21,23-25,27-28,30-32,34-35,37-39,41-42 and 44-46 of the present application.

This is a provisional obviousness-type double patenting rejection because the conflicting claims have not in fact been patented.

Claim Rejections - 35 USC § 102

6. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

Art Unit: 2621

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

7. Claims 15,16,17,18,,23,24,25,,30,31,37,39,44 and 46 rejected under 35

U.S.C. 102(e) as being anticipated by Kato et al (US 20050019007 A1).

Regarding claims 15-18 , Kato teaches a recording/ reproducing apparatus (Figs. 1) having means or recording still pictures and audio data (audio title set) on and from a computer recordable medium (Figs. 3,4), the computer-readable recording medium having a data structure for managing reproduction of still pictures, comprising: a playlist area storing at least one playlist, the playlist including at least one playitem and at least one sub-playitem, the playitem providing navigation information for reproducing at least one still picture from a first file (Figs. 11,13 sections 0225-0231), the sub-playitem providing navigation information for reproducing audio data from a second file (Fig. 7,14,26, sections 0177-0179), the presentation data are multiplexed as a transport stream (sections 0177-0179, Figs. 90,105).

Regarding claims 15-18, wherein the playitem provides navigation information for reproducing presentation data from the first file, the presentation data includes at least the still picture and related data associated with the still picture (thumbnail data (column 9, lines 50-55)).

Regarding claims 23, 30, 37 and 44, Kato teaches the presentation data is multiplexed into a transport stream on a still picture unit by still picture unit basis (Figs. 90,125, sections 0177-0179).

Regarding claims, 24, 31, 38 and 45, Kato teaches wherein each elementary stream of the presentation data is aligned within the still picture unit (Fig. 7, 13-14 and 26).

Regarding claims 25, 32, 39 and 46, Kato further teaches a data area storing the first file, and the first file does not include audio data (Fig. 26).

Claim Rejections - 35 USC § 103

8. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of the various claims was commonly owned at the time any inventions covered therein were made absent any evidence to the contrary. Applicant is advised of the obligation under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was not commonly owned at the time a later invention was made in order for the examiner to consider the applicability of 35 U.S.C. 103(c) and potential 35 U.S.C. 102(e), (f) or (g) prior art under 35 U.S.C. 103(a).

Art Unit: 2621

9. Claims 20-21,27-28,34-35 and 41-42 are rejected under 35 U.S.C. 103(a) as being unpatentable over Kato et al in view of Otomo et al (6532335) .

Regarding claims 20-22,27-28,34-36 and 41-43,Kato fails to teach that the relate data are is graphic data , subtitle data and/ or the presentation data associated with one still picture data .

Otomo teaches a recording/reproducing apparatus for recording audio file and video file on a medium having a control means for generating the graphic data or subtitle data for a still picture (column 27, lines 10-15). It would have been obvious to one of ordinary skill in the art to modify Kato with Otomo by providing a control means as taught by Otomo the apparatus of Kato for generating graphic data or subtitle data for one still picture thereby enhancing the capacity of the apparatus of Kato.

10. Claims 15,16,17,18,20-21,23,24,25, 27-28,,30,31, 34-35, 37,39,41-42, 44 and 46 are rejected under 35 U.S.C. 103(a) as being unpatentable over Nonomura et al (6,574,419) in view of Okada et al (6,266,483) .

Regarding claims 15-18 , Nonomura teaches a recording/ reproducing apparatus (Figs. 3) having means or recording still pictures and audio data (audio title set) on and from recordable medium (Figs. 3,4), the medium having a data structure for managing reproduction of still pictures, comprising:
a playlist area storing at least one playlist, the playlist including at least one playitem and at least one sub-playitem, the playitem providing navigation information for reproducing at least one still picture from a first file (Figs 5,6, 8, column 8, lines 15-68)),

Art Unit: 2621

the sub-playitem providing navigation information for reproducing audio data from a second file (column 6, lines 38-60).

Nonomura further teaches the playitem provides navigation information for reproducing presentation data from the first file, the presentation data includes at least the still picture and related data associated with the still picture (thumbnail data (column 8, lines 15-68)).

Nonomura fails to specifically teach the presentation data is multiplexed into a transport stream .on a still picture unit by still picture unit basis .

Okada teaches multiplexing the data into a transport stream ((column 5, lines 20-28)).

It would have been obvious to one of ordinary skill in the art to modify Nonomura with Okada by using the teaching of multiplexing the data of Okada to multiplexing the presentation data of Nonomura into a transport stream as an alternative to the stream data of Nonomura.

Regarding claims, 24, 31, 38 and 45, Nonomura as modified with Okada further teaches wherein each elementary stream of the presentation data is aligned within the still picture unit (Nonomura Figs. 5-7).

Regarding claims 25, 32, 39 and 46, Nonomura further teaches a data area storing the first file, and the first file does not include audio data (Figs 7, 10).

Regarding claims 20-21,,27-28,34-35 and 41-42, Nonomura further teaches that the relate data are is graphic data , subtitle data and/ or the presentation data associated with one still picture data (Figs. 7,28).

11. Any inquiry concerning this communication or earlier communications from the examiner should be directed to HUY T. NGUYEN whose telephone number is (571)272-7378. The examiner can normally be reached on 8:30AM -6:00PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Thai Q. Tran can be reached on (571) 272-7382. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/HUY T NGUYEN/
Primary Examiner, Art Unit 2621